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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,689	11/06/2003	Vinay Mehta	FDN-2815	8995

7590 01/20/2006

GAF MATERIALS CORPORATION

Attn: William J. Davis, Esq.
Legal Department, Building No. 10
1361 Alps Road
Wayne, NJ 07470

EXAMINER

COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/702,689

Applicant(s)

MEHTA ET AL.

Examiner

Elizabeth M. Cole

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
4a) Of the above claim(s) 19-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/29/04;11/6/03</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a non-asphaltic underlayment, classified in class 442.
 - II. Claims 19-22, drawn to a method of manufacturing, classified in class 156.
 - III. Claims 23-25, drawn to a roofing system, classified in class 52.
 - IV. Claims 26-29, drawn to a breathable water-resistant coating, classified in class 442.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different products such as an underlayment not comprising a breathable thermoplastic film.
4. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as for use as a waterproofing underlayment for a wall. See MPEP § 806.05(d).
5. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

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shown to be separately usable. In the instant case, invention IV has separate utility such as a coating for a concrete foundation. See MPEP § 806.05(d).

6. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions include a method of manufacturing a non-asphaltic underlayment and a roofing system which serve different functions and have different modes of operation.

7. Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions include a method of manufacturing a non-asphaltic underlayment and a breathable, water resistant coating which have different modes of operation and different functions.

8. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention the breathable, water resistant coating has separate utility such as use for a concrete foundation. See MPEP § 806.05(d).

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and or

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their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

10. During a telephone conversation with Mr. William J. Davis on December 20, 2005 a provisional election was made with traverse to prosecute the invention of group I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

11. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 18, it is not clear what is meant by "non-water-resistant polypropylene substrate". Does this mean that the substrate is permeable or porous to water? Polypropylene by nature is hydrophobic and water resistant. It will be assumed for purposes of the art rejection below, that a fabric layer would be considered non-water resistant since the fabric would be porous.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-2, 4-7, 12, 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 1,245,620. EP '620 discloses a breathable film material comprising a polyolefin resin such as polypropylene which is laminated to a substrate such as a polyolefin nonwoven fabric. See paragraph 0001. The material is suitable for use in forming waterproofing sheets for roofs. The film may further comprise additives such as alumina to impart heat and flame resistance. See paragraph 0009. With regard to claim 17, claim 17 recites a statement of intended use and does not structurally further limit the structure set forth in claim 1.

14. Claims 1-2, 4-8, 10, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 9637668, (abstract – a complete translation of this document has been ordered and will be included with the next office action). WO '668 discloses a barrier laminate comprising a breathable film layer comprising polyurethane and a substrate layer. The substrate layer may comprise woven, felt, knitted or nonwoven fabrics. The substrate layer is coated with the film layer. The substrate layer may comprise natural or synthetic fibers such as cotton, linen, jute, hemp, sisal, regenerated or modified cellulosic fibers, mineral fibers, polyester, polyamide, polyacrylic or PVC fibers. With regard to claim 17, claim 17 recites a statement of intended use and does not structurally further limit the structure set forth in claim 1.

15. Claims 1-2, 4-7, 10, 13-14, 17, 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Albertone et al, U.S. Patent NO. 6,645,336. Albertone discloses a breathable film which may comprise polyether, polyurethane, polyether ester, polyether amide, polyvinyl alcohol polymers and copolymers. See col. 4, lines 37-56. The

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breathable film is bonded to a substrate such as a polyolefin nonwoven fabric. See col. 5, lines 45-col. 7, lines 3. A tie layer of copolymers comprising ethylene vinyl acetate can be used to facilitate bonding between the film and nonwoven substrate layer. With regard to claim 17, claim 17 recites a statement of intended use and does not structurally further limit the structure set forth in claim 1. The laminated film is useful in roofing. The thickness of the film encompasses the claimed range. See 20-60 um.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1,245,620. EP '620 discloses a laminate material as set forth above. EP '620 differs from the claimed invention because it does not disclose the claimed thickness of the substrate. With regard to the thickness of the substrate, it would have been obvious to one of ordinary skill in the art at the time the invention was made to selected the thickness of the substrate through the process of routine experimentation in order to arrive at a laminate which had the desired strength, weight, breathability, etc.

18. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over each of EP 1,245,620, WOWO 9637668, Albertone et al, U.S Patent no. 6,645,336 each in view of Kuhnel et al, U.S. Patent No. 4,511,619. Each of EP '620, WO '668 and Albertone disclose breathable laminates which comprise a film layer and a fabric

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substrate layer. None of the cited references teaches disposing the film on both sides of the fabric substrate layer. Kuhnel teaches that in forming roofing materials that the film can be disposed on both sides of the fabric so that the fabric can strengthen the film. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have disposed film layers on both sides of the substrate in each of the primary references, in order to allow the substrate to fully strength the film layers.

19. Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albertone et al, U.S. Patent No. 6,645,336 in view of Kirchberger et al, U.S. Patent No. 6,300,257. Albertone discloses a breathable laminate as set forth above. Albertone does not disclose that the polymer layer or the tie layer comprises methyl methacrylate. Kirchberger teaches that methyl methacrylate can be added to layers of breathable roofing materials in order to improve the interlaminar bonding strength of layers which contain ethylene copolymers. See col. 3, lines 9-17. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added methyl methacrylate to the tie layers and film layers of Albertone, motivated by the expectation that this would further enhance the interlaminar bonding strength of the material.

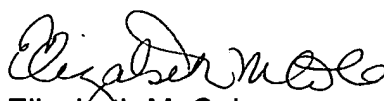
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Elizabeth M. Cole".

Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c